

## REMARKS

Reconsideration and allowance of the above-reference application are respectfully requested. Claims 1-3, 6-7, 9, 11-16, 20, 35, 45, and 53 are amended. Claims 1-3, 5-22, 24-29, 35-37, and 39-41, and 43-53 are pending in the application.

Claims 1, 2, 6-12, 15, 16, 18, 20, 21, 25-31, 34-36, 40-47 and 49 were rejected under 35 USC 103 in view of U.S. Patent No. 5,544,234 to Terajima et al. and U.S. Patent Publication 2003/0095542 A1 by Chang. This rejection is respectfully traversed, because the rejection fails to establish a *prima facie* case of obviousness.

### No Suggestion of Writing Data Received via a Voice over IP Call

As admitted in the Official Action, Terajima et al. does not disclose nor suggest recording data from an incoming Voice over IP call in an application server, where the incoming call is received via a gateway configured for receiving *Voice over IP calls*. Rather, the rejection admits on page 5 that “Terajima discloses the above processes are performed based upon receiving requests directly at the telephone rather than through a packet network gateway, as Terajima only explicitly discloses conventional POTS network calls.”

In fact, Terajima et al. describes a consumer device, namely a facsimile machine (Fig. 1) that has an automatic answering telephone 16 configured for automatically answering an incoming call in response to detection of the call.

Since Terajima does not disclose or suggest recording data from an incoming Voice over IP call in an application server (via a gateway), but rather a consumer device, the Examiner has the burden of demonstrating that one having ordinary skill in the art would have been motivated to modify Terajima in order to include the features as claimed. In fact, the Examiner has failed to satisfy this burden.

Specifically, the Examiner relies on Chang to assert that “an IP telephony module 59 [is] capable of *receiving* both a voice and fax calls over the internet using IP protocol (claims 1, 11, 16, 20, 35, 45, 53 - *receiving initiation and to reject messages through a gateway*).”

However, Chang provides no disclosure or suggestion whatsoever that the disclosed IP telephony module 59 is capable of “receiving” voice or fax calls, as claimed, let alone receiving *initiation* and *reject* messages, as claimed. In fact, paragraphs 105, 106 and 227 explicitly specify that the IP telephony module 59 (including the Voice over IP submodule 60 and the fax over IP submodule 61) are no more than “object oriented abstractions” of IP telephony; further, the IP telephony module 59 simply provides a voice over IP connection between a caller device (e.g., a caller fax machine) and a called device (e.g., a called fax machine). In fact, paragraph 227 explicitly specifies that the gateway server does not receive any Voice over IP calls for the purpose of recording that message, but rather transfers the call between source and destination fax machines.

Hence, the supposed motivation (enabling Terajima to be applied to voice/fax calls communicated over packet networks as well as conventional POTS networks) would result in a hypothetical combination that discloses no more than a consumer fax machine a calling party premises sending a fax or voice call to a consumer fax machine at a called party premises, where the PSTN network is substituted by a Voice over IP network.

However, the hypothetical combination neither discloses nor suggests that an application server *writes data* received from *an incoming Voice over IP call*, as claimed. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). The naked reference to Voice over IP is insufficient to establish obviousness of the claimed application server receiving the claimed request and reject message *from the gateway*.

For this reason alone the §103 rejection must be withdrawn.

#### No Disclosure or Suggestion of Concurrent Messaging Sessions

The hypothetical combination of Terajima and Chang neither discloses nor suggests the claimed feature in claims 12, 16, and 53 of the gateway outputting first and second requests for *concurrent* messaging sessions.

Terajima consistently and unequivocally teaches that the Network Control Unit (NCU) 107 is configured for **switching** a call connection (using a relay 1 in the NCU 107) **from** the answering telephone 16 **to** the facsimile apparatus in response to detection of the facsimile tones. **Each and every embodiment** in Terajima teaches switching the relay **from** the answering telephone 16 **to** the facsimile apparatus.

In fact, the claims of Terajima require that one of the answering phone or fax machine be disconnected at any time, or that the step of “changing over the switch” be performed (see, e.g., claims 1, 9, 16, 21, 24, 30).

Hence, Terajima et al. *consistently* describes that the call connection is **switched** by the relay 1 in the NCU 107 in response to the fax tone detection by the CNG detector 7 in the NCU 107 (see, e.g., Figs. 2, 4, 6, 8) or in the modem 106 coupled to the NCU 107 (e.g., Fig. 5, col. 7, lines 23-31). Therefore, any attempt to modify Terajima to eliminate the switch as described (**and claimed**) by Terajima would be improper. Hence, since the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143.01, page 2100-132 (Rev. 2, May 2004) (*citing In re Ratti*, 123 USPQ 349 (CCPA 1959)).<sup>1</sup>

Further, any attempt to remove the switch in Terajima (in order to provide concurrent messaging sessions, as claimed) would destroy the invention of Terajima and would therefore be

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<sup>1</sup>The Examiner is reminded that the proposed modification cannot change the principle operation of a reference or render it unsatisfactory for its intended purpose. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01, Rev. 5, Aug. 2006 at p. 2100-130 (Citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). “If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *Id.* at 2100-129 (Citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Cf. MPEP §2145.III at page 2100-159 (Rev. 5, Aug. 2006) (“the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose.”).

improper. See Ex parte Hartmann, 186 U.S.P.Q. 366, 367 (P.T.O.B.O.A. 1974) (reversing rejection when modification would destroy basis for invention in one or two references). Therefore, the rejection should be withdrawn.

For these and other reasons, the §103 rejection is legally deficient and must be withdrawn.

It is believed the remaining dependent claims are allowable in view of the foregoing.

In view of the above, it is believed this application is in condition for allowance, and such a Notice is respectfully solicited.

To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including any missing or insufficient fees under 37 C.F.R. 1.17(a), to Deposit Account No. 50-1130, under Order No. 95-462, and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'L R Turkevich', with a long horizontal flourish extending to the right.

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**Date: January 16, 2007**